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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,895	02/24/2004	Eduard K. de Jong	SUN-P9178	6753
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GUNNISON MCKAY & HODGSON, LLP 1900 GARDEN ROAD SUITE 220 MONTEREY, CA 93940			EXAMINER LE, UYEN CHAU N	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/786,895

Applicant(s)

DE JONG, EDUARD K.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/04, 7/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

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**DETAILED ACTION**

***Specification***

1. The disclosure is objected to because of the following informalities:

Re specification, page 2, paragraph [0001], lines 2, 6 and 10: The Applicant fails to provide the specific related applications.

Appropriate correction is required.

***Claim Objections***

2. Claims 10, 30 and 49 are objected to because of the following informalities:

Re claim 10, line 3: Substitute "application" with - application. --.

Re claim 30, line 4: Substitute "application" with - application. --.

Re claim 49, line 3: Substitute "application" with - application. --.

Appropriate correction is required.

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-18 and 21-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Saltz (US 2005/0149926A1).

Re claims 1-18 and 21-57: Saltz discloses a method for selecting a desired application on a Java card 202, which serves as a smart card, wherein there are potentially two or more applications [A-G] installed on the smart card 202, each application having a stored application identifier (AID), the method comprising: specifying a desired application in terms of multiple parameters; retrieving multiple parameters from a stored AID for an application on the smart card 202; and comparing the specified multiple parameters with the retrieved multiple parameters to determine whether or not there is a match (paragraphs [0038-0055]); wherein the smart card 202 is separated into one or more firewalls, with each application

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installed on the smart card being contained within one of the firewalls, and wherein one of the parameters is indicative of the firewall in which the desired application is contained (paragraphs [047-0053]; wherein one of the parameters comprises an applet ID that identifies an application within a firewall (paragraphs [0053-0054]; wherein one of the parameters comprises a registered application provider identifier (RID) (paragraph [0055]); wherein the RID comprises a predetermined first portion of the AID, and one or more remaining parameters are contained within a predetermined second portion of the AID (paragraph [0055]); wherein the multiple parameters comprise an RID, a firewall identifier, and an applet identifier (paragraphs [0053-0055]); wherein the smart card 202 is brought into communication with a terminal (i.e., card acceptance device 224), and the terminal transmits a request to the smart card specifying a desired application in terms of the multiple parameters (paragraph [0039]); further comprising returning to the terminal in response to the request the AID of an application whose retrieved parameters match the specified parameters (paragraphs [0039-0040]); wherein the request is received by an applet selector on the smart card, and the applet selectors calls a method on a control value 302, which serves as an AID interpreter associated with each application on the smart card

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to perform the retrieving (paragraphs 0045-0052]); wherein the AID interpreter 302 associated with each application performs the comparing and notifies the applet selector of whether or not there is a match for that application (paragraphs [0048-00850]); wherein the applet selector performs the comparing of the specified parameters with the retrieved parameters for each application (paragraphs [0048-00850]).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 4, 19-20, 40-41, 43 and 58-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (US 5,530,232).

Re claims 1-2, 4, 19-20, 40-41, 43 and 58-59: Taylor discloses a method for selecting a desired application on a smart card 10, wherein there are potentially two or more applications (i.e., American Express, Visa, Master Charge, Discovery, various oil companies, various hotels, and various airlines) installed on the smart card 10, each application having a stored application identifier (AID) (i.e., account

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number), the method comprising: specifying a desired application in terms of multiple parameters (i.e., PIN); retrieving multiple parameters from a stored AID for an application on the smart card 10; and comparing the specified multiple parameters with the retrieved multiple parameters to determine whether or not there is a match (i.e., it's inherently that the inputted PIN has to be compared with the specified/stored PIN for verification and authentication) (col. 3, line 46 through col. 4, line 47 and col. 5, lines 12-47); wherein the smart card 10 is separated into one or more firewalls, with each application installed on the smart card being contained within one of the firewalls, and wherein one of the parameters is indicative of the firewall in which the desired application is contained (i.e., separated PIN and account number for each application) (fig. 1); wherein one of the parameters comprises a registered application provider identifier (RID) (i.e., vendor code) (col. 3, lines 55-67); bringing a first card 10 into communication with a terminal (i.e., card reader 14); bringing a second card 18 into communication with the terminal 14; wherein the terminal specifies the same desired application in terms of the same multiple parameters for each of the first and second cards [10, 18]; and wherein a first matching application having a first AID is identified on the first card and a second

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matching application having a second AID is identified on the second card, wherein the first AID is different from the second AID, wherein the first AID shares a common initial portion with the second AID, and wherein the multiple parameters are not completely contained within the common initial portion (fig. 2; col. 4, lines 14-57).

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Pitroda (US 5590038 A); Claus et al (US 5857079 A); Bradley et al (US 6024286 A); Brake, Jr. et al (US 6032136 A); Hohle (US 6199762 B1); Blossom (US 6631849 B2); Saltz (US 20050138354 A1) are cited as of interest and illustrate a similar structure to a method and apparatus for selecting a desired application on a smart card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on First Monday 5:30AM-1:30PM and Tues-Fri 5:30AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be



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reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Uyen-Chau N. Le  
Examiner  
AU 2876

September 28, 2005